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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,810

10/18/2005

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EXAMINER

TRAN, MY CHAU T

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,810	Applicant(s) BURNETT ET AL.	
	Examiner MY-CHAU T. TRAN	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Office Action</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application and Claims Status

1. Applicant's preliminary amendment filed 10/18/2008, which amended the instant specification, acknowledged and entered.
2. Claims 1-9 are currently pending and are under consideration in this Office Action.

Priority

3. This instant application is a 371 of PCT/US04/03320 filed on 02/05/2004, and as a result this instant application has the effective filing date of 02/05/2004. The PCT/US04/03320 also claimed priority to provisional application number 60/465,042 filed 04/24/2003, which is acknowledged.

Information Disclosure Statement

4. The information disclosure statements (IDS) that were filed on 10/18/2005 and 05/26/2006 have been reviewed, and the references that have been considered are initialed as recorded in PTO-1449 forms.

Specification

5. The substitute specification filed 10/18/2005 has been entered.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the limitations of “*means for receiving a power-off command, means for maintaining the lamp in an off- condition during a predetermined cool-down period following receipt of the power-off command, means for receiving a power-on command during the predetermined cool-down period, and means for automatically powering on the lamp at the end of the predetermined cool-down period if the power-on command is received during the predetermined cool-down period*”. These limitations invoke 35 U.S.C. 112, sixth paragraph, i.e. the means (or step)-plus-function claim limitation. See MPEP §2181. However, the instant specification does not provide adequate description, i.e. in specific terms, of the corresponding structure, material or acts for *each* of these means (or step)-plus-function claim limitations, but rather a single structure in broad generic terms, i.e. a control circuit (ref. #103) (see specification section: [00015]; fig. 1). Accordingly, the instant specification does not provide support these means (or step)-plus-function claim limitations, and fails to comply with 35 U.S.C. 112, first paragraph.

If applicants disagree, applicant should present a detailed analysis as to why the claimed subject matter has clear support in the specification.

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8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recite the limitations of “*means for receiving a power-off command, means for maintaining the lamp in an off- condition during a predetermined cool-down period following receipt of the power-off command, means for receiving a power-on command during the predetermined cool-down period, and means for automatically powering on the lamp at the end of the predetermined cool-down period if the power-on command is received during the predetermined cool-down period*”. These limitations invoke 35 U.S.C. 112, sixth paragraph, i.e. the means (or step)-plus-function claim limitation. See MPEP §2181. However, the instant specification does not provide adequate description, i.e. in specific terms, of the corresponding structure, material or acts for *each* of these means (or step)-plus-function claim limitations, but rather a single structure in broad generic terms, i.e. a control circuit (ref. #103) (see specification section: [00015]; fig. 1). As a result, these limitations fail to comply with 35 U.S.C. 112, second paragraph, and claim 1 and all its dependent claims are rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 9 recite a product, i.e. a program-containing computer readable medium.

Although, the term “*program-containing computer readable medium*” is not specifically define in the instant specification, the instant specification supports the interpretation of this term to encompass the definition of signals and/or software code, i.e. algorithm and/or data structures, (see instant specification section: [00015] thru [00018]), which is not eligible for patent protection under 35 U.S.C. 101. See MPEP § 2106(IV) and also *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) (“idea of itself is not patentable, but a new device by which it may be made practically useful is”); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) (“While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.”); *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759 (“steps of locating’ a medial axis, and creating’ a bubble hierarchy . . . describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic abstract idea”). Furthermore, MPEP § 2106.01(I) states that:

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the

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computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Accordingly, the product, i.e. a program-containing computer readable medium, of claim 9 is an abstract idea wherein the claimed product is neither physical "things", i.e. structural components, nor statutory processes, and as a result is consider nonstatutory subject matter (i.e. an abstract idea).

Consequently, claim 9 is rejected under 35 U.S.C. 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyashita (US Patent 5,136,397).

For **claims 1-5**, first claim 1 recite the limitations of "*means for receiving a power-off command, means for maintaining the lamp in an off- condition during a predetermined cool-down period following receipt of the power-off command, means for receiving a power-on command during the predetermined cool-down period, and means for automatically powering on the lamp at the end of the predetermined cool-down period if the power-on command is received during the predetermined cool-down period*" wherein these means (or step)-plus-function claim limitations is interpreted to be one single device, i.e. a controller. This interpretation is fully

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supported by the instant specification (see section: [00015]; fig. 1). Here, Miyashita discloses a video projection system (see e.g. Abstract; col. 2, lines 26-36; fig. 2). As illustrated by figure 2, the system comprises a control unit (ref. #32) (refers to instant claimed means (or step)-plus-function claim limitations) and a lamp (see e.g. col. 4, lines 12-42). The control unit (ref. #32) can performed the claimed functions of *‘receiving a power-off command, maintaining the lamp in an off- condition during a predetermined cool-down period following receipt of the power-off command receiving a power-on command during the predetermined cool-down period, and automatically powering on the lamp at the end of the predetermined cool-down period if the power-on command is received during the predetermined cool-down period’* and instant claim 2 (see e.g. col. 8, lines 13-59; fig. 11A and 11B). The system further comprises LED (refers to instant claim 3), a timer (refers to instant claim 4), and a counter (refers to instant claim 5) (see e.g. see e.g. col. 8, lines 13-59).

For **claims 6-8**, Miyashita discloses the method of cooling control that comprises the steps of maintaining the lamp in an off condition during a predetermined cool-down period following receipt of a power-off command; automatically powering on the lamp at the end of the cool-down period if a power-on command was received during the cool-down period; signaling receipt of a power-on command during the cool-down period; and blinking an indicator for the remainder of the cool-down period following receipt of a power-on command during the cool-down period (see e.g. col. 8, lines 13-59; fig. 11A and 11B).

For **claim 9**, Miyashita discloses a program that performs the method of cooling control (see e.g. col. 8, lines 13-59; fig. 11A and 11B).

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Therefore, the device, product, and method of Miyashita do anticipate the instant claimed invention.

Conclusion

14. No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T. TRAN whose telephone number is (571)272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MY-CHAU T. TRAN/
Primary Examiner, Art Unit 2629

November 29, 2008